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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,407	11/10/2003	Satoshi Mizutani	20050/0200481-US0	4396

7278 7590 07/26/2006

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EXAMINER

STEPHENS, JACQUELINE F

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 07/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/705,407

Applicant(s)

MIZUTANI

Examiner

Jacqueline F. Stephens

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11, 12 and 14-20 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/12/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 4/26/06 have been fully considered but they are not persuasive. Applicant argues Schlangen fails to teach or suggest that the embossed polymeric film produces a 'low friction shape' such that a resisting force associated with two faces formed by folding the embossed film sliding against each other would be reduced over another design using films that lack such fine changes, such that each face can make right and left phase shifts when the interlabial pad is folded. Applicant further argues Schlangen teaches a polymeric film that is embossed to promote softness and compliance in contrast to applicant's claimed back side sheet which precludes contact between surfaces having a like composition in order to reduce friction. Applicant describes on pages 7, 8, 15, 17, and 18 sheet materials for the water impermeable sheet with the claimed fine changes on the surface are embossed portions that can be a variety of shapes. Schlangen teaches similar materials for the water impermeable sheet and teaches the sheet is embossed as discussed below. Because the prior art teaches the same structure as the claimed invention, the prior art would obviously possess the same properties or functions of the claimed invention. (MPEP 2112-2112.01). Also, the fact that Johnson/Schlangen provides a sheet that is compliant and conforms to the external shape and contours of the human anatomy does not preclude the sheet material from providing a low friction shape that reduces resisting force when sliding with another face having the same low friction shape. Additionally, applicant has not claimed the sheet precludes contact between surfaces. Although the

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claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claim 1-8, 11, 12, 14-16, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson USPN 4595392 in view of Schlangen USPN 5618282.

As to claims 1-4, 8, 14, and 16, Johnson discloses an interlabial pad having a water-permeable surface side sheet 7, an absorbent body 6, and a back side sheet 8. The interlabial pad comprises a cylindrical portion 3 in which a finger can be inserted for use (Figure 3), wherein the cylindrical portion 3 comprises the sheets 7 and 8 and absorbent body 6 (Figure 3). Regarding the limitation of a low resistance material, this is a relative term and the examiner considers the materials of Johnson to be low resistance as compared to an abrasive material.

However, Johnson does not disclose fine changes on its surface on the side opposite the body side. Schlangen discloses an interlabial pad having a baffle 24 with an embossed surface, which is micro-embossed to provide softness and render the material compliant to conform to the contours of the human anatomy (col. 4, lines 17-24). One having ordinary skill in the art would have been motivated to modify the baffle of Johnson with micro-embossing to aid in compliancy and softness as taught by Schlangen. The limitations of sliding with another face and the low friction shape making right and left phase shifts is directed to an intended use of the article. "Intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963)." If the prior art structure is capable of performing the intended use, then it meets the claim limitations.

As to claim 5, Johnson/Schlangen is silent as to the emboss rate. However, the embossed rate would have been obvious by optimizing the amount of embossing on the nonwoven, and the softness, compliancy, and vapor permeability could be optimized by one of ordinary skill in the art for the same reason. Discovering optimum values only involves routine skill in the art, *In re Boesch*, 617 F. 3d 272, 205 USPQ 215 (CCPA 1980).

As to claims 6 and 15, Johnson/Schlangen discloses a fiber assembly, Johnson col. 2, lines 31-36.

As to claim 7, Johnson/Schlangen does not specifically disclose a nonwoven fabric. However, Johnson discloses the absorbent material and wrap can be any suitable materials for this purpose. It is old and well known in the art to use nonwovens in absorbent articles for the purpose of absorbing exudates.

As to claim 18, the interlabial pad of Johnson/Schlangen comprises a mini sheet 6 (Johnson Figure 2).

As to claims 11, 12, 19, and 20, the limitations of absorbing vaginal discharge is directed to an intended use of the article. "Intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. See *In re Casey*, 152 USPQ 235

(CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).” If the prior art structure is capable of performing the intended use, then it meets the claim limitations.

6. Claim 9 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson USPN 4595392 in view of Schlangen USPN 5618282 and further in view of Wray et al. USPN 6332878. Johnson discloses the present invention substantially as claimed. However, Johnson does not disclose a lubricant. Wray discloses an interlabial pad having a lubricant for the benefit of assisting in positioning (col. 2, lines 46-50). It would have been obvious to one having ordinary skill in the art to modify the invention of Johnson with a lubricant for the benefits taught in Wray.

Allowable Subject Matter

7. Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

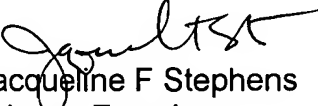
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline F. Stephens whose telephone number is (571) 272-4937. The examiner can normally be reached on Monday-Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jacqueline F Stephens
Primary Examiner
Art Unit 3761

July 24, 2006